

REMARKS

Applicants submit this Reply in response to the Final Office Action dated December 31, 2002 and the Advisory Action dated June 25, 2003. Claims 19-29 are pending and under consideration. Favorable reconsideration of the subject application is respectfully requested in view of the remarks provided herein.

Rejection under 35 U.S.C. § 103(a)

Claims 19-29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Van Eldik *et al.*, Okada *et al.*, and Shibue *et al.* for the reasons already on record. More specifically, the Action alleges that Van Eldik *et al.* teaches two different monoclonal antibodies specific for S100 $\beta$ , Okada *et al.* teaches dual antibody ELISAs wherein the antibodies are bound to a magnetic particle carrier, and Shibue *et al.* teaches dual antibody ELISAs wherein the immunoreactant measurement is performed via electrochemiluminescence using luminol. The Action concludes that it would, therefore, have been obvious to the skilled artisan to use the monoclonal antibodies of Van Eldik *et al.* in the dual antibody ELISA assays of Okada *et al.* and Shibue *et al.* using magnetic carrier immobilization and detection via chemiluminescence. The Action further asserts that the skilled artisan would have been motivated to perform such a dual antibody ELISA assay based upon the advantages taught by Okada *et al.* and Shibue *et al.* and would have expected positive results based upon the success achieved in the cited references and the high degree of skill in the relevant art. Finally, the Advisory Action asserts that no evidence as to the epitope specificity of the prior art antibodies has been presented that would exclude them from the claim limitations or from use in a dual antibody sandwich assay.

Applicants respectfully traverse this rejection for the reasons already on record and on the following grounds.

Applicants respectfully submit that the Action's basis of rejection necessarily implies that the antibodies described by Van Eldik *et al.*, inherently recognize two different

epitopes, *i.e.*, the epitopes of the presently claimed invention, and are therefore able to function in the presently claimed assay. According to section 2112 of the M.P.E.P.:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1997 (Fed. Cir. 1993) (emphasis in original)(MPEP § 2112).

Further, the M.P.E.P. states that:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (MPEP § 2112).

Applicants respectfully submit that the Action has not met the burden of making it clear that the missing descriptive matter is necessarily present in the cited prior art reference, *i.e.*, Van Eldik *et al.*. In fact, the Action concedes that the cited prior art reference is silent regarding the specific structure and epitope specificity of the monoclonal antibodies. Applicants, therefore, submit that the Action has merely raised a possibility that the antibodies of Van Eldik *et al.*, may bind to the epitopes described in the instant application. As made clear by the M.P.E.P., such conjecture does not suffice as a finding that the prior art reference contains a disclosure that anticipates the presently claimed invention. Moreover, as evidenced by the Declaration of Dr. Aronsson, filed in Applicants' response of May 28, 2003, the descriptive matter that the Action alleges is necessarily present in the thing described in the reference would not be so recognized by persons of ordinary skill. Accordingly, Applicants respectfully submit that the combined disclosure of Van Eldik *et al.*, Okada *et al.*, and Shibue *et al.*, cannot reasonably render obvious to the skilled artisan the currently claimed invention, since the combined disclosure of these references fails to teach, suggest, or otherwise motivate a skilled artisan to arrive at Applicants' methods employing two distinct S100 $\beta$  antibodies that are specific for two distinct epitopes of the S100 $\beta$  protein. Reconsideration and withdrawal of this rejection is thus respectfully requested.

The Commissioner is authorized to charge any additional fees due by way of this Reply, or credit any overpayment, to our Deposit Account No. 19-1090.

Applicants respectfully submit that the claims remaining in the application are now believed to be allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

Seed Intellectual Property Law Group PLLC



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Enclosure:

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